

REMARKS-General

1. The above amended claims are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112. No new matter has been included.

Response to Rejection of Claims 1-40 under 35USC103

2. The Examiner rejected claims 1-4, 7-40 over Dukash et al in view of Lutterbach et al and Giraud and claims 5-6 over Dukash et al in view of Lutterbach et al and Giraud and further in view of Rakavy et al.

3. Pursuant to 35 U.S.C. 103: "(a) A patent may not be obtained thought the invention is **not identically disclosed** or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

4. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

5. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Dukash et al which appears to be qualified as prior art of the instant invention under 35USC102(e) are obvious in view of Lutterbach et al and Giraud and Rakavy et al at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

6. The applicant respectfully submits that in order to determine whether the differences between the subject matters sought to be patent as a whole of the instant

invention and the primary prior art, Dukash et al, are obvious in view of the supplemental cited arts, Lutterbach et al, Giraud and/or Rakavy et al, we have to identify all the differences between the claims of the instant inventions and Dukash et al. The applicant respectfully identifies the differences between the claims of the instant invention and Dukash et al as follows:

- (a) In claims 1 and 39, "**a plurality of regional service centers and regional control centers in a plurality of regional territories in one or more countries**" is included to manage and communication with electronic posters and to serve and accept posting order from the advertisers, wherein Dukash et al merely teaches a central system directly transmitting messages to electronic displays mounted on vehicles that fails to suggest any regional service and control centers in different territories to serve as a powerful communication and transmission bridge between the stationary electronic posters and the "**central control system which is networked with the regional service and control centers through a public network**";
- (b) In claims 1 and 39, "**one or more stationary electronic posters built in each of the regional territories**" is claimed, wherein Dukash et al merely suggests moving electronic displays mounted on vehicles wherein vehicles provide no stationary regional territories for advertisements. In order words, Dukash et al does not itself teach the concept of stationary regional territories and electronic posters built in stationary manner so that the potential customers and their response can be monitored by the monitor devices for the advertisers and the central control center as claimed in claims 33 to 38 of the in instant invention.

In addition, it is only the Examiner's allegation that "the billboards that are mounted on the vehicles can be considered to be stationary at least when stuck in traffic, when at stoplights and when parked" while Dukash et al did not provide any of such suggestion or description in its disclosure. It is inappropriate for the Examiner to reject an invention based on his or her own assumption but not the facts disclosed in the cited arts. The applicant respectfully submits that "stationary" means having a fixed position and established in one place (Webster's Encyclopedic Unabridged Dictionary) which is not equivalent to temporarily stuck or parking of a vehicle. A vehicle would not be considered as a stationary object. Also, it is apparent that **mobile-message** is the main objective and achievement of Dukash et al since Dukash specifically emphasizes

the incorporation of GPS receiver or electromagnetic receiver in the vehicle to receive messages from the central system.

(c) In claims 1 and 39, "**each of the electronic posters is maintained and controlled by the respective regional control center and networked with the central control system through the respective regional control center**" is included to claim the relationship between the electronic posters, the regional control centers and the central control system while Dukash et al provides no regional control and service centers because, according to the idea of **mobile message display**, the vehicle may move around the country and it is nearly impossible to establish any stationary control or service regions for the display mounted on the moving vehicle.

(d) The claims 1 and 39 claim "**the accepting of posting orders from advertisers by the regional service centers and each of the regional service centers obtaining information of where and when** is each of the electronic posters available", wherein the advertisers can take advantage of the regional service centers, which would use same language and know the domestic market and needs of the advertisers, to take posting orders and information, however Dukash et al fails to teach any regional service centers that the customers must place order to the central system directly through e-commerce site.

(e) Dukash et al does not contain the step of "**sending each of the posting orders to the central control system from the respective regional service center**" as claimed in claim 1.

(f) Dukash et al does not "**sending the recorded poster content to the regional control centers** in charge of the electronic posters designated by the respective advertiser" as claimed in claim 1.

(g) Dukash et al does not contain the step of "**booking and confirming advertising time with one or more of the regional control centers controlling the electronic posters** designated by the respective advertiser by the central control system" as claimed in claim 1.

(h) In claims 1 and 39, "**each of the electronic posters being always remained electronically controlled by the respective regional control center**" is

claimed while there is no suggestion of regional control center in Dukash et al to control the electronic posters in 24 hours basis.

(i) Dukash et al does not include a step of "affirming the posting orders by the central control system by **confirming posting schedules of each of the posting orders with one or more of the regional control centers** that in charge of the electronic posters designated by the respective advertiser" as claimed in claim 2 in addition to what is claimed in claim 1 as a whole.

(j) Dukash et al does not teach the step of "**translating the poster content into one or more native languages**" as claimed in claims 5 to 6 in addition to what is claimed in claim 1 as a whole.

(k) Dukash et al does not teaches the step of "**providing a suggested schedule and reference for different categories of services and products by each of the regional control centers to the central control system** to post advertisements thereof in different time period a day in each of the electronic posters **within the regional territory**" as claimed in claims 7-9.

(l) In claims 16-17 and 20, "**each of the posting order for each of the electronic posters being sent with a posting code which includes at least a poster code assigned to represent the electronic poster**" is claimed while Dukash et al fails to teach such concept.

(m) The claims 18-19 and 21 claim that "**each of the regional service centers and regional control centers is assigned with a service code and a control code respectively, wherein in each of the posting orders, the service code clearly indicates which of the regional service centers does the posting order and the control code indicates which of the regional control centers in charge the electronic poster**" while Dukash et al does not teach the idea of service code and control code.

(n) According to claims 25-28, "**the poster contents of the posting orders are downloaded to the corresponding regional control centers**" while Dukash et al merely teaches the central system downloads **messages** to the displays mounted on the vehicles in a wireless manner. In fact, for a moving vehicle, in order to download

information, there are limited transmission sources can be used, such as radio frequency, cellular network, and the super expensive satellite connection. It is why Dukash et al merely discloses throughout the specification and claims that only small memory messages will be transmitted and displayed. For video and audio advertisement and information, it is nearly impossible to download such huge media files through such wireless networks for moving vehicles.

(o) Dukash et al does not mention any of that "**two or more poster contents are allowed to arrange to share a full screen of the electronic poster at the same time**" as claimed in claims 29-32.

(p) In claims 33-38, "**a monitor device is installed adjacent to each of the electronic posters for monitoring each of the electronic posters in real time manner and sending back a feedback and posting stage instantly to the regional control center and the central control system through the public network**", wherein Dukash et al merely teaches cameras to gather other information such as traffic and weather information but fails to suggest the real time feedback concept for advertisers and central control center to make appropriate posting order with effective content at effective time for targets customers around the stationary spots of the stationary electronic posters as suggested in the instant invention.

7. Whether the claims 1 to 40 as amended of the instant invention are obvious depends on whether the above differences (a) to (p) between the instant invention and Dukash et al are obvious in view of Lutterbach et al, Giraud and/or Rakavy et al at the time of the invention was made.

8. Furthermore, the applicant respectfully submits that when applying 35 USC 103, the following tenets of patent law must be adhered to:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (c) The references must be viewed without the benefit of hindsight vision afforded by the claimed invention; and

(d) Reasonable expectation of success is the standard with which obviousness is determined.

Also, "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." *Libbey-Owens-Ford v. BOC Group*, 4 USPQ 2d 1097, 1103 (DCNJ 1987).

9. Lutterbach et al merely teaches an interactive video display system without any suggestion of how such video display system be possibly equipped in a networked electronic poster system through public network.

10. Giraud merely suggests a LCD screen with motion detector to track the exposure of consumer to control the display time. Similarly, neither Dukash nor Giraud suggests a method and system of posting electronic poster through public network containing the above distinctive features (a) to (p) as claimed in the instant invention as well as any combination or possibility of providing a monitor device installed adjacent to each of the electronic posters for monitoring each of the electronic posters in real time manner and sending back a feedback and posting stage instantly to the regional control center and the central control system through the public network.

11. Rakavy et al merely teaches methods and apparatus for transmitting and displaying information between a remote network and a local computer without any suggestion of how to place order and display posters in different regional territories all over the world with different languages by providing the **regional control and services centers** as claimed in the instant invention.

12. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness..." *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991).

13. Accordingly, the applicant believes that neither Dukash et al, Lutterbach et al, Giraud nor Rakavy et al, separately or in combination, suggest or make any mention whatsoever of the difference subject features (a) to (p) as claimed in the amended claims 1 to 40 of the instant invention.

14. In addition, the applicant also needs to submit herewith that pursuant to 35USC102(e)(2), a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the Untied States and was published under Article 21(2) of such treaty in the English language.

15. The cited art, the international application, Dukash et al, was filed on December 15, 2000 and claimed priority dates of December 15, 1999 (60/170,914) and August 16, 2000 (60/226,000) and published on June 21, 2001. In other words, effective filing date of Dukash et al is December 15, 1999. Accordingly, the applicant respectfully submits that Dukash et al is not qualified to be a prior art under 35USC102(e) for 35USC103 rejection because of at least the following reasons. First, Dukash et al did not enter the US national phase so that it is not a United States patent application nor granted United States patent. Second, the publication date of Dukash et al was later than the effective filing date, January 17, 2001, of the instant invention. Third, the effective filing date of Dukash et al is December 15, 1999 which was before November 29, 2000, so that no 35USC102 date as reference for Dukash et al. In other words, Dukash et al reference is prior art as of its publication date under 35USC102(a) or (b).

16. Accordingly, Dukash et al is not a qualified prior art of the instant invention and should be removed from the prior art list of the instant invention.

17. In view of the above, it is submitted that the amended claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 1 to 40 at an early date is solicited.

18. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: August 25, 2005

Signature: 
Person Signing: Raymond Y. Chan